

REMARKS

The Advisory Action mailed August 23, 2004 has been received and reviewed. Claims 1 through 15 and 21 through 24 are noted as pending in the Advisory Action and continue to be rejected.

Claims 1, 8 and 14 are amended herein and claims 3 and 23 are canceled. Claims 16 through 20 were earlier canceled. Applicants note the proposed amendments to the claims contained in the Amendment After Final submitted July 19, 2004 have not been entered and the present amendments are made relative to the immediate prior version of the claims. A Request for Continued Examination (RCE) is being submitted herewith. Reconsideration of the application as amended is thus respectfully requested.

35 U.S.C. § 112 First Paragraph Rejections

Claims 1 through 15 and 21 through 24 were rejected in the Final Office Action as assertedly failing to comply with the written description requirement under the first paragraph of 35 U.S.C. § 112. The Final Office Action stated that “the claim(s) contain subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.” (Final Office Action at page 2).

Applicants presented a proposed amendment to claim 14 and remarks addressing these rejections in the Amendment After Final, submitted July 19, 2004. In the Advisory Action, entry of these amendments was refused and the request for reconsideration was deemed not to place the application in condition for allowance. Each of these issues is addressed in turn below, as appropriate.

In the Advisory Action, the proposed amendment of claim 14 was refused entry as assertedly raising “new issues that would require new grounds of rejection under 35 U.S.C. 112, first paragraph,” with respect to the language “providing the capsid or envelope of said virus with the first member of the specific binding pair.” The Advisory Action asserts such language would introduce new matter as “[t]he specification only teaches capsid/envelope modification by recombinant expression of antigens that insert into the viral capsid or envelope.” (Advisory Action at page 2).

Although applicants respectfully disagree with this conclusion, in order to expedite allowance claim 14 is amended herein to recite “The kit of parts according to claim 8, wherein said virus is derived from a virus selected from the group consisting of adenoviruses, adeno-associated viruses, and retroviruses **by modification of the capsid or envelope of said virus by recombinant expression of the first member of the specific binding pair that inserts into the viral capsid or envelope.**” This language is supported in the specification, as acknowledged in the Advisory Action. Applicants thus respectfully submit that amended claim 14 does not introduce new matter

The rejection of claims 1 through 15 and 21 through 24 in the Final Office Action as assertedly failing to comply with the written description requirement under the first paragraph of 35 U.S.C. § 112 was continued in the Advisory Action, which stated the “request for reconsideration was considered but does not place the application in condition for allowance” (Advisory Action, page 1, numbered item 5). More specifically, the Advisory Action stated that “[w]hile the invention described in the specification **includes** the use of a native viral antigen as the first member of the specific binding pair it does not contemplate a scope where the use of native viral antigen is **excluded.**” (Advisory Action at pages 2 to 3, emphasis in original). Although applicants respectfully disagree with the assertion in the Office Actions that the negative limitations constitute new matter, independent claims 1 and 8 are amended herein to expedite allowance.

As amended, independent claim 1 now recites: “preparing a gene delivery vehicle comprising an expressible nucleic acid molecule encoding a recombinant gene of interest, a virus including a capsid or envelope surrounding said expressible nucleic acid molecule, and a first member of a specific binding pair, said first member of the specific binding pair **being expressed by recombinant expression** on an exterior of said capsid or envelope.” Similarly, independent claim 8 now recites: “said first member of the specific binding pair **being expressed by recombinant expression** on an exterior of said capsid or envelope.” The negative limitation rejected in the Final Office Action and the Advisory Action is no longer present in these claims and, as noted previously herein, the Advisory Action states the specification “teaches capsid/envelope modification by **recombinant expression** of antigens that insert into the viral

capsid or envelope.” (Advisory Action at page 2, emphasis added). Such support may be found at paragraphs [0046] through [0051] of the as-filed specification. Applicants thus respectfully submit no new matter is present.

CONCLUSION

All pending claims are believed to be in condition for allowance, and an early notice thereof is respectfully solicited. Should the Office determine that additional issues remain which might be resolved by a telephone conference, the Examiner is respectfully invited to contact applicants' attorney.

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